

PATENT



Docket No. RSW920010004US1

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JGW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTORS: M. Peters, J. Hind, and S. Sarkar

Examiner: S. Ismail
Art Unit: 2155

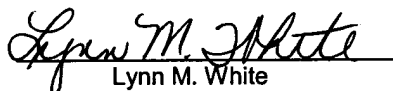
APPLICATION NO. 09/784,881

FILED: February 16, 2001

TITLE: METHOD FOR AUTOMATICALLY DIRECTING BROWSER TO
BOOKMARK A URL OTHER THAN A URL REQUESTED FOR
BOOKMARKING

CERTIFICATE OF MAILING

I hereby certify that this paper is being deposited with the U.S. Postal Service as First Class Mail, postage prepaid, in an envelope addressed to Commissioner for Patents, MAIL STOP APPEAL BRIEF-PATENTS, P.O. Box 1450, Alexandria, VA 22313-1450, Attention: Board of Patent Appeals and Interferences on July 18, 2005.


Lynn M. White

Commissioner for Patents
MAIL STOP APPEAL BRIEF-PATENTS
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Alexandria, VA 22313-1450

Attention: Board of Patent Appeals and Interferences

APPELLANTS' BRIEF

This brief is in furtherance of the Notice of Appeal filed in this case on May 12, 2005. The Commissioner is hereby authorized to charge the fee for filing this Appeal Brief (\$500.00) to Deposit Account No. 09-0461.

This brief is transmitted in triplicate.

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1. REAL PARTY IN INTEREST

The present application is assigned to International Business Machines Corporation, having its principal place of business at New Orchard Road, Armonk, New York 10504. Accordingly, International Business Machines Corporation is the real party in interest.

2. RELATED APPEALS AND INTERFERENCES

The appellant, assignee, and the legal representatives of both are unaware of any other appeal or interference which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

3. STATUS OF CLAIMS

- A. Claims canceled: None
- B. Claims withdrawn from consideration but not canceled: None
- C. Claims pending: 1-16
- D. Claims allowed: none
- E. Claims rejected: 1-16
- F. Claims appealed: 1-16

Appealed claims 1-16 as currently pending are attached as Appendix A hereto.

4. STATUS OF AMENDMENTS

A Reply under 37 C.F.R. §1.111 was filed on September 8, 2004; no claim amendments were made. In response, the Examiner issued the final Office Action appealed herein.

A Reply under 37 CFR §1.116 was filed on February 14, 2005; claim amendments were made. The examiner did NOT enter the amendments, and the submission of the Reply did not result in allowance by the Examiner.

A Supplemental Reply under 37 CFR §1.116 was filed concurrently with this Brief¹.

5. SUMMARY OF THE CLAIMED SUBJECT MATTER

Independent claim 1 defines: a method of causing a web browser to bookmark an alternate (see Amendment after Final filed concurrently herewith) URL rather than a target URL (*page 9, lines 11-14*). The method comprises the insertion of an alternate bookmark directive in an encoded web page representation associated with the target URL (*page 7, lines 16-18*). The alternate bookmark directive causes the web browser to bookmark the alternate URL instead of the target URL when a user of the web browser attempts to bookmark the target URL (*page 7, line 18-page 8, line 4*).

¹ In the Supplemental Reply under 37 CFR §1.116, the term "alternative bookmark directive" has been changed to "alternate bookmark directive" and the term "alternative URL" has been changed to "alternate URL". This is to correct a typographical error and to maintain consistency, since both terms are used interchangeably throughout the application. Throughout this Brief, the term "alternate" will be utilized.

Independent claim 5 defines: a method of causing a web browser to bookmark an alternate URL rather than a target URL (*page 9, lines 11-14*). The method comprises the insertion of an alternate bookmark directive in an encoded web page associated with said target URL (*page 7, lines 16-18*), accessing said target URL using said web browser; and directing said web browser to bookmark said target URL, said alternate bookmark directive causing said web browser to bookmark said alternate URL instead of said target URL (*page 7, line 18-page 8, line 4*).

Independent claim 9 defines: a computer program product causing a web browser to bookmark an alternate URL rather than a target URL (*page 9, lines 11-14*). The method comprises the insertion of an alternate bookmark directive in an encoded web page representation associated with said target URL (*page 7, lines 16-18*), said alternate bookmark directive causing said web browser to bookmark said alternate URL instead of said target URL when a user of said web browser attempts to bookmark said target URL (*page 7, line 18-page 8, line 4*).

Independent claim 13 defines: a system causing a web browser to bookmark an alternate URL rather than a target URL (*page 9, lines 11-14*). The method comprises the insertion of an alternate bookmark directive in an encoded web page representation associated with said target URL (*page 7, lines 16-18*), said alternate bookmark directive causing said web browser to bookmark said alternate URL instead of said target URL when a user of said web browser attempts to bookmark said target URL (*page 7, line 18-page 8, line 4*).

The present invention provides a method for automatically bookmarking a URL specified by a web author when a user of a web browser attempts to bookmark a different page or when a process updates bookmarks based on either the HTTP 301 return code or the HTML meta refresh markup.

U.S. Patent No. 6,658,402 to Dutta

U.S. Patent No. 6,658,402 to Dutta ("Dutta") teaches a system, method and program whereby a hyperlinking site-map of a server is created and stored along with a bookmark for a page. On clicking a bookmark, if the page is not found, another close page is obtained by the client. If an attempt to reach a particular page fails because the page is no longer existent on the site, the links in the chain represented by the site map are followed back from that page to the root page.

U.S. Patent No. 6,041,360 to Himmel et al.

U.S. Patent No. 6,041,360 to Himmel et al. ("Himmel") teaches access to the Internet using dynamic bookmarks. The Examiner relies upon Himmel for an asserted teaching of the dynamic updating of bookmarks using encoding in XML as a web page representation.

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. The rejection of claims 1, 2, 4-6, 8-10, 12-14 and 16 under 35 U.S.C. §102 based on Dutta.
2. The rejection of claims 3, 7, 11 and 15 under 35 U.S.C. §103 based on Dutta in view of Himmel.

7. ARGUMENT

- A. The Cited Art Does Not Teach or Suggest the Use of an Alternate Bookmark Directive Inserted in a Web Page to Cause the Bookmarking of the Alternate URL instead of the Target URL**

The Cited Prior Art Does Not Anticipate the Claimed Invention

The MPEP and case law provide the following definition of anticipation for the purposes of 35 U.S.C. §102:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP §2131 citing *Verdegaal Bros. v. Union Oil Company of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987).

As noted above, the present claimed invention includes the insertion of an "alternate bookmark directive" in an encoded web page representation associated with a target URL that is being bookmarked². This predetermined alternate bookmark directive is predetermined by the web author, i.e., it is inserted in the encoded web page representation of the target URL to cause the alternate URL to be bookmarked instead of the target URL. It is specific, i.e., the web designer plans it ahead of time as evidenced by both the specification ("a URL specified by a web author" - page 7, lines 13-14) and the claims ("A method of causing a web browser to bookmark an alternate URL rather than a target URL"). This occurs regardless of whether or not the target URL is available.

Dutta contains no such teaching. Dutta provides a useful invention in that a site map is established so that, if a particular web page that is bookmarked is no longer available, the site map can be used to track back to a previous web page that is available. This is a good and helpful idea; however, it does not teach or suggest the present invention, whereby an alternate bookmark directive is encoded in web pages, and this alternate bookmark directive automatically causes any attempt to bookmark the target URL to actually bookmark the alternate URL, even if the target is available. In preferred embodiments that are claimed in dependent claims, the alternate URL is the homepage of the website associated with the target URL.

Each of the independent claims (and thus all dependent claims as well), specifically claim the insertion of an alternate bookmark directive as defined in the specification. Since

² The Board is requested to consider the term "alternate" as "alternative" if the Examiner refuses to enter the Supplemental Reply filed concurrently herewith.

the claims specifically claim this element, and since there is no teaching (nor suggestion) of these claimed elements in Dutta, claims 1, 2, 4-6, 8-10, 12-14 and 16 (and all claims depending therefrom) patentably define over Dutta. Accordingly, the Board is respectfully requested to reverse the Examiner's rejection of claims 1, 2, 4-6, 8-10, 12-14 and 16 based on Dutta.

The Examiner has not Established a *prima facie* Case of Obviousness

As set forth in the MPEP:

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

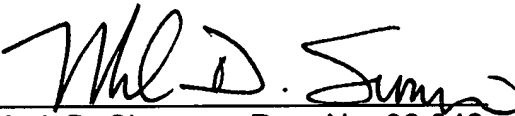
MPEP 2143

The Examiner relies upon U.S. Patent No. 6,041,360 to Himmel for an alleged teaching of the use of encoding in XML as a web page representation in connection with dynamic updating of bookmarks. Applicant does not deny that Himmel teaches that XML may be used to represent a web page. However, nothing in Himmel teaches or suggests the encoding of a predetermined alternate bookmark directive in any form (e.g., XML or HTML). Himmel simply discloses the updating of a traditional bookmark because the browser sees itself being redirected by the response headers when fetching a page, or it sees standard data markup in the page that is used in naming or classifying the bookmark. Without any teaching or suggestion of the encoding of an alternate bookmark directive as is claimed in each of the claims of the present invention, the addition of Himmel provides no basis for rejection of the claims.

Accordingly, the Board is respectfully requested to reverse the Examiner's rejection of claims 3, 7, 11 and 15 under 35 U.S.C. §103.

Respectfully submitted:

July 18, 2005
Date


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CLAIMS APPENDIX

CLAIMS INVOLVED IN THIS APPEAL:

1. (Original) A method of causing a web browser to bookmark an alternative URL rather than a target URL, comprising the step of:

inserting an alternative bookmark directive in an encoded web page representation associated with said target URL, said alternative bookmark directive causing said web browser to bookmark said alternative URL instead of said target URL when a user of said web browser attempts to bookmark said target URL.
2. (Original) A method as set forth in claim 1, wherein said encoded web page representation is encoded in HTML.
3. (Original) A method as set forth in claim 1, wherein said encoded web page representation is encoded in XML.
4. (Original) A method as set forth in claim 1, wherein said web browser periodically checks all URLs associated with bookmarks stored by said browser to determine if any of said URLs have an alternative bookmark directive associated therewith and, if so, causing said web browser to bookmark said alternative URL instead of the target URL.

5. (Original) A method of causing a web browser to bookmark an alternative URL rather than a target URL, comprising the steps of:

inserting an alternative bookmark directive in an encoded web page associated with said target URL;

accessing said target URL using said web browser; and

directing said web browser to bookmark said target URL, said alternative bookmark directive causing said web browser to bookmark said alternative URL instead of said target URL.

6. (Original) A method as set forth in claim 5, wherein said encoded web page representation is encoded in HTML.

7. (Original) A method as set forth in claim 5, wherein said encoded web page representation is encoded in XML.

8. (Original) A method as set forth in claim 5, wherein said web browser periodically checks all URLs associated with bookmarks stored by said browser to determine if any of said URLs have an alternative bookmark directive associated therewith and, if so, causing said web browser to bookmark said alternative URL instead of the target URL.

9. (Original) A computer program product causing a web browser to bookmark an alternative URL rather than a target URL, comprising the step of:

inserting an alternative bookmark directive in an encoded web page representation associated with said target URL, said alternative bookmark directive causing said web browser to bookmark said alternative URL instead of said target URL when a user of said web browser attempts to bookmark said target URL.

10. (Original) A computer program product as set forth in claim 9, wherein said encoded web page representation is encoded in HTML.

11. (Original) A computer program product as set forth in claim 9, wherein said encoded web page representation is encoded in XML.

12. (Original) A computer program product as set forth in claim 9, wherein said web browser periodically checks all URLs associated with bookmarks stored by said browser to determine if any of said URLs have an alternative bookmark directive associated therewith and, if so, causing said web browser to bookmark said alternative URL instead of the target URL.

13. (Original) A system causing a web browser to bookmark an alternative URL rather than a target URL, comprising the step of:

inserting an alternative bookmark directive in an encoded web page representation associated with said target URL, said alternative bookmark directive causing said web browser to bookmark said alternative URL instead of said target URL when a user of said web browser attempts to bookmark said target URL.

14. (Original) A system as set forth in claim 13, wherein said encoded web page representation is encoded in HTML.

15. (Original) A system as set forth in claim 13, wherein said encoded web page representation is encoded in XML.

16. (Original) A system as set forth in claim 13, wherein said web browser periodically checks all URLs associated with bookmarks stored by said browser to determine if any of said URLs have an alternative bookmark directive associated therewith and, if so, causing said web browser to bookmark said alternative URL instead of the target URL.

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EVIDENCE APPENDIX

None supplied.

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RELATED PROCEEDINGS APPENDIX

None supplied.



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PATENT

Docket No. RSW920010004US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR(S): Marcia L. Peters
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Soumitra Sarkar
APPL. NO. 09/784,881
FILED: February 16, 2001

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Confirmation No. 5202
Examiner: S. Ismail
Art Unit: 2155

TITLE: METHOD FOR AUTOMATICALLY DIRECTING BROWSER
TO BOOKMARK A URL OTHER THAN A URL REQUESTED
FOR BOOKMARKING

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to Examiner S. Ismail, Art Unit 5202, to facsimile number 571 273 8300 on July 18, 2005.


Lynn M. White

Commissioner for Patents
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Alexandria, VA 22313-1450

Attention: Board of Patent Appeals and Interferences

**SUPPLEMENTAL REPLY UNDER 37 C.F.R. §1.116
TO EXAMINER'S FINAL ACTION MAILED DECEMBER 14, 2004**

Sir:

This is in further response to the final Office Action mailed December 14, 2004. The following amendments and remarks are respectfully submitted.

Amendments to the specification begin on page 2 of this paper; amendments to the claims begin on page 3 of this paper; Remarks begin on page 6 of this paper.

In the Specification

Please amend the paragraph that appear on page 9, lines 10-14 as follows.

If the selected URL does not contain an ~~alternative~~ alternate bookmark directive, at step 118 the target URL is bookmarked in a known manner. If, however, at step 116 a determination is made that the selected URL does contain an ~~alternative~~ alternate bookmark directive, then at step 120 the alternate bookmark identified in the alternate bookmark directive is bookmarked, instead of the target bookmark.

Please amend the paragraph that bridges pages 13 and 14 as follows.

As with any new browser function, the first implementing product would choose the details of the tagging technique to convey the ~~alternative~~ alternate bookmark directive and would provide web authors with this information so they could take advantage of the new function. Over time, other products choosing to also provide the function would recognize this tagging convention in their product code. Such a possible convention is shown in the above example, namely that an HTML author inserts a “meta” element having a “name” attribute with the value of “BOOKMARK_AS” and a “content” attribute having the value of the URL to be used into the HTML file representing the web page to indicate to the browser that the respective URL should be used when bookmarking the page.

In the Claims

1. (Currently amended) A method of causing a web browser to bookmark an alternative alternate URL rather than a target URL, comprising the step of:

inserting an alternative bookmark directive in an encoded web page representation associated with said target URL, said alternative alternate bookmark directive causing said web browser to bookmark said alternative alternate URL instead of said target URL when a user of said web browser attempts to bookmark said target URL.

2. (Original) A method as set forth in claim 1, wherein said encoded web page representation is encoded in HTML.

3. (Original) A method as set forth in claim 1, wherein said encoded web page representation is encoded in XML.

4. (Currently amended) A method as set forth in claim 1, wherein said web browser periodically checks all URLs associated with bookmarks stored by said browser to determine if any of said URLs have an alternative alternate bookmark directive associated therewith and, if so, causing said web browser to bookmark said alternative alternate URL instead of the target URL.

5. (Currently amended) A method of causing a web browser to bookmark an alternative alternate URL rather than a target URL, comprising the steps of:

inserting an alternative alternate bookmark directive in an encoded web page associated with said target URL;

accessing said target URL using said web browser; and

directing said web browser to bookmark said target URL, said alternative alternate bookmark directive causing said web browser to bookmark said alternative alternate URL instead of said target URL.

6. (Original) A method as set forth in claim 5, wherein said encoded web page representation is encoded in HTML.

7. (Original) A method as set forth in claim 5, wherein said encoded web page representation is encoded in XML.

8. (Currently amended) A method as set forth in claim 5, wherein said web browser periodically checks all URLs associated with bookmarks stored by said browser to determine if any of said URLs have an alternative alternate bookmark directive associated therewith and, if so, causing said web browser to bookmark said alternative alternate URL instead of the target URL.

9. (Currently amended) A computer program product causing a web browser to bookmark an alternative alternate URL rather than a target URL, comprising the step of:
inserting an alternative alternate bookmark directive in an encoded web page representation associated with said target URL, said alternative alternate bookmark directive causing said web browser to bookmark said alternative alternate URL instead of said target URL when a user of said web browser attempts to bookmark said target URL.

10. (Original) A computer program product as set forth in claim 9, wherein said encoded web page representation is encoded in HTML.

11. (Original) A computer program product as set forth in claim 9, wherein said encoded web page representation is encoded in XML.

12. (Currently amended) A computer program product as set forth in claim 9, wherein said web browser periodically checks all URLs associated with bookmarks stored by

said browser to determine if any of said URLs have an alternative alternate bookmark directive associated therewith and, if so, causing said web browser to bookmark said alternative alternate URL instead of the target URL.

13. (Currently amended) A system causing a web browser to bookmark an alternative alternate URL rather than a target URL, comprising the step of:

inserting an alternative alternate bookmark directive in an encoded web page representation associated with said target URL, said alternative alternate bookmark directive causing said web browser to bookmark said alternative alternate URL instead of said target URL when a user of said web browser attempts to bookmark said target URL.

14. (Original) A system as set forth in claim 13, wherein said encoded web page representation is encoded in HTML.

15. (Original) A system as set forth in claim 13, wherein said encoded web page representation is encoded in XML.

16. (Currently amended) A system as set forth in claim 13, wherein said web browser periodically checks all URLs associated with bookmarks stored by said browser to determine if any of said URLs have an alternative alternate bookmark directive associated therewith and, if so, causing said web browser to bookmark said alternative alternate URL instead of the target URL.

REMARKS

Applicant has amended various portions of the specification and claims to make consistent use of the term "alternate" as in the terms "alternate URL" and "alternative bookmark directive." Both terms were used interchangeably in the original specification. This amendment ensures that the terminology is used consistently throughout the specification. The terms are essentially identical and thus no new matter has been introduced as a result of this amendment.

The Commissioner is hereby authorized to charge any fee associated with this communication to Deposit Account No. 09/0461.

Respectfully submitted

July 18, 2005
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